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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/729,866 | 12/06/2000 | Hideaki Yamanaka | 200500US2 | 7895 |
| 22850 | 7590 | 11/17/2005 | | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER CHARLES, DEBRA F | |
| | | | ART UNIT 3624 | PAPER NUMBER |
| DATE MAILED: 11/17/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,866

Applicant(s)

YAMANAKA ET AL.

Examiner

Debra F. Charles

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>July 8, 2005</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed Sept. 21, 2005 have been fully considered but they are not persuasive. Stefik does indicate payment to the content holder via a computer system that clearly uses a server. Since the payment can be made via a server, regardless of the term used for the server whether it be payment server or administrator server, it is obvious that an advertising fee collection and payment just like the content fee collection and payment is within the invention's scope. This is discussed as per the quoted paragraph below from Stefik, col. 2, line 65 to col. 3, line 50:

While flexibility in distribution is a concern, the owners of a work want to make sure they are paid for such distributions. In U.S. Pat. No. 4,977,594 to Shear, entitled "Database Usage Metering and Protection System and Method," a system for metering and billing for usage of information distributed on a CD-ROM is described. The system requires the addition of a billing module to the computer system. The billing module may operate in a number of different ways. First, it may periodically communicate billing data to a central billing facility, whereupon the user may be billed. Second, billing may occur by disconnecting the billing module and the user sending it to a central billing facility where the data is read and a user bill generated.

(14) U.S. Pat. No. 5,247,575, Sprague et al., entitled "Information Distribution System", describes an information distribution system which provides and charges only for user selected information. A plurality of encrypted information packages (IPs) are provided at the user site, via high and/or low density storage media and/or by broadcast transmission. Some of the IPs may be of no interest to the user. The IPs of interest are

selected by the user and are decrypted and stored locally. The IPs may be printed, displayed or even copied to other storage medias. The charges for the selected IP's are accumulated within a user apparatus and periodically reported by telephone to a central accounting facility. The central accounting facility also issues keys to decrypt the IPs. The keys are changed periodically. If the central accounting facility has not issued a new key for a particular user station, the station is unable to retrieve information from the system when the key is changed.

(15) A system available from Wave Systems Corp. of Princeton, N.Y., provides for metering of software usage on a personal computer. The system is installed onto a computer and collects information on what software is in use, encrypts it and then transmits the information to a transaction center. From the transaction center, a bill is generated and sent to the user. The transaction center also maintains customer accounts so that licensing fees may be forwarded directly to the software providers. Software operating under this system must be modified so that usage can be accounted.

(16) Known techniques for billing do not provide for billing of copies made of the work. For example, if data is copied from the CD-ROM described in Shear, any subsequent use of the copy of the information cannot be metered or billed. In other words, the means for billing runs with the media rather than the underlying work. It would be desirable to have a distribution system where the means for billing is always transported with the work.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2,3, 5,6,7,8,9,10,11,12,13,17,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis(U.S.PUB. 2001/0041053A1), Flavin et al.(U.S.PAT. 6219788B1), Reilly et al.(U.S.PAT. 5740549A), and Stefik et al.(5629980A).

Claim 2: Abecassis disclose a digital content billing system using a network, comprising:
an advertiser configured to possess an advertising information piece to be provided for the user(Abstract, page 1, para 0015); and
obtain the advertising information piece from the advertiser(Abstract, page 2, para 0034-0035, page 3, para 0036),
receive an execution declaration of the digital content from the user(page 25, para 0390-0391).

Abecassis disclose(s) the claimed invention except the execution key to the user through the network; a holder configured to have digital content, which is set to become usable by an execution key, and holding a right to let a user use the digital content; a distributor configured to obtain the digital content from the holder and to distribute the digital content to a user; and

an administrator configured to obtain the execution key from the holder. However, in Abstract, col. 4, lines 25-60, col. 5, lines 15-40 thereof, Flavin et al. disclose(s) an authentication unit and process with watchdog to monitor and give access permission. It would be obvious to one of ordinary skill in the art to modify the invention of Abecassis based on the teachings of Flavin et al. The motivation to combine these references is to validate a set of operations performed by the processing engine and transmitting an authenticating signal responsive to user input.

Abecassis and Flavin et al. disclose(s) the claimed invention except the number of execution times of the digital content used by the user. However, in col. 5, line 60-col. 6, line 10, thereof, Reilly et al. disclose the number of times the new item which is digital content is accessed by the user. It would be obvious to one of ordinary skill in the art to modify the invention of Abecassis and Flavin et al. based on the teachings of Reilly et al. The motivation to combine these references is to ensure accurate pay-per-use pricing transactions.

Abecassis, Flavin et al. and Reilly et al. disclose(s) the claimed invention except download the advertising information piece, collect an advertisement rate from the advertiser and pay an execution fee to the holder that, corresponds to the number of execution times of the digital content. However, in col. 8, line 55 – col. 9, line 10, col. 15, lines 5-20, col. 17, lines 1-50, Stefik et al. disclose various fees for access and a fee for transactions which is an execution fee since a transaction is executed on the server. It would be obvious to one of ordinary skill in the art to modify the invention of Abecassis, Flavin et al. and Reilly et al. based on the teachings of Stefik et al. The motivation to combine these references is to ensure accurate pay-per-use pricing transactions.

Claim 3: Abecassis, Flavin et al. and Stefik et al. disclose(s) the claimed invention except the advertising information piece downloaded to the user is displayed simultaneously with the digital content. However, in Fig. 6, col. 4, line 65-col. 5, line 10, col. 8, lines 45-67, col. 11, lines 30-40, claim 2 thereof, Reilly et al. disclose advertising that is downloaded and displayed with the digital content. It would be obvious to one of ordinary skill in the art to modify the invention of Abecassis, Flavin et al. and Stefik et al. based on

the teachings of Reilly et al. The motivation to combine these references is to effectively and efficiently display the content and advertisement together to save user time.

Claim 5: Abecassis discloses the distributor notifies the holder of the number of download times of the digital content downloaded to the user, and the holder pays to the distributor a download charge, that corresponds to the number of download times of the digital content(page 25, para 0388).

Claim 6: Abecassis discloses when the administrator receives the execution declaration from the user the administrator downloads to the user a plurality of advertising information pieces which permits the user to use the digital content a prescribed number of times(page 3, para. 0036, page 25, para. 0382-0388, page 26, para. 0409-0412, page 27, para 0413-0421).

Claims 7 and 8: Abecassis, Reilly et al. and Stefik et al. disclose the invention except when the execution key is not currently downloaded to the user from the administrator because of an abnormal state even though a

prescribed time has passed after the user sent the execution declaration of the digital content the user uses the digital content by using an execution key downloaded from the administrator in the past while seeing an advertising information piece downloaded from the administrator in the past; And after the abnormal state has passed the user notifies the administrator that the user used uses the digital content by using the execution key downloaded from the administrator in the past.

However, in Abstract, col. 3, lines 35-col. 4, lines 60, col. 5, lines 15-40 thereof, Flavin et al. disclose(s) an authentication unit and process with watchdog to monitor and give access permission based on normal or abnormal states. It would be obvious to one of ordinary skill in the art to modify the invention of Abecassis and Reilly et al. based on the teachings of Flavin et al. The motivation to combine these references is to validate a set of operations performed by the processing engine and transmitting an authenticating signal responsive to user input and normal or abnormal states.

Claim 9: Abecassis disclose the advertising information piece downloaded from the administrator to the user corresponds to content of the digital content(page 2, para 0034-0035).

Claim 10: Abecassis disclose when the administrator receives the execution declaration of the digital content from the user the administrator requires the user to select a genre of the advertising information piece to be downloaded to the user and the advertising information of the selected genre, is downloaded to the user(page 2, para 0022-0035, page 3, para. 0036, page 25, para. 0382-0388, page 26, para. 0409-0412, page 27, para 0413-0421).

Claim 11: Abecassis disclose wherein when the administrator receives the execution of declaration of the digital content from the user the administrator downloads to the user the advertising information piece, that corresponds to content of another digital content used by the user in the past(page 2, para 0022-0035,page 3, para. 0036, page 25, para. 0382-0388, page 26, para. 0409-0412, page 27, para 0413-0421).

Claim 12: Abecassis disclose the administrator collects the advertisement rate from the advertiser that is determined according to a matching point between content of the digital content related to the execution declaration of the user and content of the advertising information piece downloaded from the administrator to the user(Abstract, page 2, para 0034-0035, page 3, para 0036, page 26, para 0393-0394).

Claim 13: Abecassis disclose the administrator guarantees the advertiser a minimum number of downloading times the advertising information piece is downloaded to the user or a minimum ratio of the number of downloading times the advertising information piece is downloaded to the user to the number of downloading times of all advertising information pieces downloaded to the user(page 3, para. 0036, page 25, para. 0382-0388, page 26, para. 0409-0412, page 27, para 0413-0421).

Re Claims 17 and 19: Abecassis disclose an advertiser configured to possess an advertising information piece to be provided for a user(Abstract, page 1, para 0015);

a holder configured to receive the advertising information piece from the advertiser(Abstract, page 2, para 0034-0035, page 3, para 0036), having digital content, a distributor configured to obtain from the holder the digital content that includes the advertising information piece, and to distribute the digital content with the advertising information piece to the user(Abstract, page 2, para 0034-0035, page 3, para 0036, page 26, para 0393-0394);

receive an execution declaration of the digital content from the user(page 25, para 0390-0391),

the holder collects an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user(Abstract, page 2, para 0034-0035, page 3, para 0036, page 26, para 0393-0394).

Abecassis disclose(s) the claimed invention except the and an administrator configured to obtain the execution key from the holder, that is set to become usable by an execution key, and to hold a right to let a user use the digital content, download the execution key to the user through the

network; of the execution key downloaded from the administrator to the user. However, in Abstract, col. 4, lines 25-60, col. 5, lines 15-40 thereof, Flavin et al. disclose(s) an authentication unit and process with watchdog to monitor and give access permission. It would be obvious to one of ordinary skill in the art to modify the invention of Abecassis based on the teachings of Flavin et al. The motivation to combine these references is to validate a set of operations performed by the processing engine and transmitting an authenticating signal responsive to user input.

Abecassis, Flavin et al. and Stefik et al. disclose(s) the claimed invention except and notify the advertiser of the number of execution times of the digital content used by the user; and the holder pays a download charge to the administrator, that corresponds to the number of download times. However, in col. 5, line 60-col. 6, line 10, Fig. 6, col. 4, line 65-col. 5, line 10, col. 8, lines 45-67, col. 11, lines 30-40, claim 2 thereof, Reilly et al. disclose the number of times the new item which is digital content is accessed by the user, and advertising that is downloaded and displayed with the digital content. It would be obvious to one of ordinary skill in the art to modify the invention of Abecassis, Flavin et al. and Stefik et al. based on

the teachings of Reilly et al. The motivation to combine these references is to ensure accurate pay-per-use pricing transactions, and to effectively and efficiently display the content and advertisement together to save user time.

Claim 18: Abecassis discloses the distributor notifies the holder of the number of download times of the digital content downloaded to the user, and the holder pays a download charge to the distributor that, corresponds to the number of download times of the digital content (page 25, para 0388).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis, Flavin et al., Reilly et al. and Stefik et al. as applied to claim 2 above, and further in view of Schlarb et al. (U.S.PAT. 6671879B1).

Abecassis, Flavin et al., Reilly et al. and Stefik et al. disclose(s) the claimed invention except the advertising information piece downloaded to the user is displayed in a time period between time periods in which the digital content is displayed. However, in col. 2, lines 5-25 thereof, Schlarb et al. disclose showing the advertisement either before or after the digital content. It would be obvious to one of ordinary skill in the art to modify the

invention of Abecassis, Flavin et al., Reilly et al. and Stefik et al. based on the teachings of Schlarb et al. The motivation to combine these references is to effectively and efficiently display the advertisement between advertising windows in a way that does not cause subscriber confusion.

6. Claims 14, 15 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis, Flavin et al., Reilly et al. and Stefik et al. as applied to claim 2 above, and further in view of Wilkins(U.S.PAT. 5446919A).

Abecassis, Flavin et al., Reilly et al. and Stefik et al. disclose(s) the claimed invention except the administrator requires the user to select a residential district of the user, and the administrator downloads to the user the digital content that, closely relates to the residential district of the user, and a nationwide digital content to the user; which is obtained from a network operator managing the network. However, in Abstract, Col. 3, line 45-col. 4, line 41, Cols. 5,6,Col. 8, line 60-col. 10, line 10, thereof Wilkins disclose regionalized and national digital content and advertising via a network manager. It would be obvious to one of ordinary skill in the art to modify the

invention of Abecassis, Flavin et al., Reilly et al. and Stefik et al. based on the teachings of Wilkins. The motivation to combine these references is to effectively and efficiently target a specific digital content and advertising to better use available advertising funds to reach those who want to receive certain ads and media.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (571) 272 6791. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (571) 272 6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HANI M. KAZIMI
PRIMARY EXAMINER

Debra F. Charles
Examiner
Art Unit 3624
